

REMARKS

In the Office Action dated July 9, 2003, the Examiner rejected claims 1, 7, 10-12, 14, 17-18, 24, 27-29, 31, and 34 -36 under 35 U.S.C. § 102(b) as anticipated by Borgendale et al., U.S. Patent No. 5,734,568. The Examiner also rejected claims 2-5, 8, 19-22, 25, and 30 under 35 U.S.C. § 103(a) as obvious over Borgendale et al. in view of Ulvir et al., U.S. Patent No. 5,602,382. Furthermore, the Examiner rejected claims 6 and 23 under 35 U.S.C. § 103(a) as obvious over Borgendale et al. in view of Berson et al., U.S. Patent No. 6,039,257, and claims 9 and 26 under 35 U.S.C. § 103(a) as obvious over Borgendale et al. in view of Ulvir et al. and Berson et al. Finally, the Examiner rejected claims 15-16 and 32-33 under 35 U.S.C. § 103(a) as obvious over Pintsov et al. in view of Allum et al., U.S. Patent No. 5,420,403.

Substance of the Interview

Applicants thank the Examiner for the courtesy extended to Applicants' representatives during a personal interview on November 18, 2003. Pursuant to section 713.04 of the Manual of Patent Examining Procedure, Applicants provide this summary of the substance of the interview. Independent claims 1, 18, 35, and 36 were discussed, as was the primary reference cited, Borgendale et al., U.S. Patent No. 5,734,568. The arguments and proposed claim amendments discussed during the interview are set forth herein.

Section 102(b) Rejections

Claims 1, 7, 10-12, 14, 17-18, 24, 27-29, 31, and 34 -36 were rejected under 35 U.S.C. § 102(b) as anticipated by Borgendale et al. To establish a *prima facie* case of

anticipation, each element recited in the patent claim must be found either explicitly or impliedly, in a single prior art reference. M.P.E.P. § 706.02. Borgendale et al. does not disclose the claimed invention, including at least several elements of claim 1, as amended. Therefore, the reference does not anticipate the claim and the rejection of claim 1 should be withdrawn.

For example, Borgendale et al. does not teach any method including retrieving identification information from an identification file at a plurality of nodes on a mailpiece sorting system. Indeed, the Office Action did not even mention this claim element. Borgendale et al. teaches an address resolution system with three nodes: a sending location, a remote processing system, and a destination location. (Borgendale et al., Fig. 1.) The sending location creates part of an electronic mailpiece folder containing information about the address on a mailpiece, and the remote processing system completes the electronic mailpiece folder using an image of the mailpiece. (Borgendale et al., col. 4, ll. 10-61.) Once the electronic folder is created, it is sent to a destination location. The destination location retrieves routing information from the electronic mailpiece folder. (Id., col. 6, ll. 21-39.) Thus, the reference does not teach a plurality of nodes that retrieve identification information from the identification file, as recited in claim 1.

Furthermore, Borgendale et al. does not teach any method which uses the identification code read from the mailpiece to retrieve identification information from the corresponding identification file at a plurality of nodes on a mailpiece sorting system. In the reference, only the destination location node even has the ability to read the

identification number from the mailpiece. (Borgendale et al., Fig. 3C.) The sending location node prints the identification number on the mailpiece; it does not read the identification number from the mailpiece. (Borgendale et al., Fig. 3A.) The remote processing system does not even receive the mailpiece, so it cannot read anything from the mailpiece. (Borgendale et al., col. 4, ll. 42 - col. 5, l. 4.) Therefore, the reference does not teach using the identification code read from the mailpiece to retrieve identification information at a plurality of nodes on a mailpiece sorting system, as recited in amended claim 1. code,

For at least the reasons given above, Borgendale et al. does not disclose the subject matter defined by amended claim 1, and the rejection of the claim should therefore be withdrawn. Independent claims 18, 35, and 36 contain similar recitations to claim 1 and were rejected for the same reasons as claim 1. Therefore, for at least the reasons given above with respect to claim 1, Borgendale et al. does not disclose the subject matter defined by claims 18, 35, and 36, as amended, and the rejections of those independent claims should be withdrawn.

Further, claims 7, 10-12, 14, and 17 depend from claim 1, and claims 24, 27-29, 31, and 34 depend from claim 18. These dependent claims cannot be anticipated by Borgendale et al. at least because the reference does not disclose several elements of the underlying independent claims. Therefore, the § 102(b) rejections of dependent claims 7, 10-12, 14, 17, 24, 27-29, 31, and 34 should be withdrawn.

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

Section 103(a) Rejections

The Examiner rejected claims 2-5, 8, 19-22, and 25 under 35 U.S.C. § 103(a) as obvious over Borgendale et al. in view of Ulvir et al., U.S. Patent No. 5,602, 382. Furthermore, under 35 U.S.C. § 103(a), the Examiner rejected claims 6 and 23 as obvious over Borgendale et al. in view of Berson et al., U.S. Patent No. 6,039,257, and claims 9 and 26 as obvious over Borgendale et al. in view of Ulvir et al. and Berson et al. Finally, the Examiner rejected claims 15-16 and 32-33 under 35 U.S.C. § 103(a) as obvious over Borgendale et al. in view of Allum et al., U.S. Patent No. 5,420,403.

To establish a *prima facie* case of obviousness, (1) the prior art references must teach or suggest each of the claim limitations, (2) some suggestion or motivation must exist, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or combine the reference teachings, and (3) one must have a reasonable expectation of success. M.P.E.P. § 2143. In the Office Action, the Examiner failed to establish a *prima facie* case of obviousness at least because the cited references fail to teach or suggest all the claim elements.

For example, at least for the reasons given above, Borgendale et al. does not teach or suggest any method that uses an identification code read from a mailpiece to retrieve identification information from the corresponding identification file at a plurality of nodes on a mailpiece sorting system. All of rejected claims 2-6, 8-9, 15-16, 19-23, 25-26, and 32-33 recite these elements through their dependence upon amended claims 1 or 18. While Borgendale et al. fails to teach or suggest at least these claim elements, none of the secondary references cure these defects. Because the

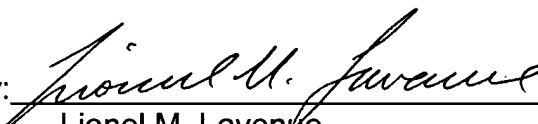
references, either alone or in combination, do not teach or suggest each of the elements of claims 2-6, 8-9, 15-16, 19-23, 25-26, and 32-33, the § 103(a) rejections of these claims should be withdrawn.

In view of the foregoing remarks, Applicant respectfully requests the reconsideration and reexamination of this application and the timely allowance of the pending claims. Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: December 9, 2003

By: 
Lionel M. Lavenue
Reg. No. 46,859

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com